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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/054,565	04/03/98	SIMPSON	J P-3489.027

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LARRY L COATS
RHODES COATS & BENNETT
PO BOX 5
RALEIGH NC 27602

EXAMINER

GOODMAN, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

08/18/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/054,565

Applicant(s)
Jack R. SIMPSON

Examiner
Charles Goodman

Group Art Unit
3724



☒ Responsive to communication(s) filed on May 28, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) 22, 23, and 25 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-21, 24, and 26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____.

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Species I, claims 1-21, 24, and 26, in Paper No. 3 is acknowledged.
2. Claims 22, 23, and 25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Election was made **without** traverse in Paper No. 3.

Specification

3. The disclosure is objected to because of the following informalities: .
 - i) P. 9, l. 12, the phrase "the cutting die 52" is not clearly understood. In ll. 3-4, reference "52" has been used to designate a "cylindrical die board or base." A "cutting die" and a "board" or a "base" are two different structures in scope. It is confusing. Thus, since it appears that the reference "52" is supposed to represent the same feature, then it is highly suggested that Applicant use consistent terminology and references throughout the specification when referring to the same. This applies to the rest of the specification.

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- ii) P. 10, l. 19, the phrase "pair of vertical sides 20" is not clearly understood when in the previous lines, reference "20" has been used to designate an "angled rear edge surface." Which is which?

Appropriate correction is required.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "weighted" scrap stripper (claim 24) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "24" (Figs. 2 and 3A). Correction is required.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "S" (p. 12, l. 5). Correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-21, 24, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with vague and indefinite language and lack of antecedent basis for claimed features. The following are some noted examples. Applicant is advised to thoroughly review all the claims and correct all instances of non-conforming language. Failure to do so will result in the next Office action being made FINAL.

- i) The following phrases lack clear antecedent basis: (claims 3 and 10) “the direction of travel”; (claim 8, l. 10) “the direction of movement”; (claim 9, l. 5) “the height”; (claim 14) “the angle”; (claim 16, ll. 3-4) “the direction of travel”; (claim 19) “where the finger and base merge”; (claim 20) “the finger”; and (claim 26) “the weighted portion” and “the influence of centrifugal force.”
- ii) In claim 1, l. 15, the term “it” is vague and indefinite. What is “it” referring to? The same applies to the rest of the claims including the term “its.”
- iii) Claim 6 is vague and indefinite in that it is not clear what the claim encompasses. What is the difference, if any, between the “erect position” and the “extended position” since these are structurally the same position of the stripper finger according to the specification? In l. 6, the phrase “a cut piece of scrap” is vague and indefinite in that it appears to be a double inclusion of the same previously recited.

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- iv) Claim 9 is vague and indefinite in that it is not clear what the claim encompasses.
What is the claim referring to, and how do these so called "limitations" further define the invention? How do they affect the method in a manipulative sense? The same applies to similar instances in the rest of the claims.
- v) Claim 11 is vague and indefinite in that it appears that most of the limitations therein are double inclusions of the same previously recited. The same applies to claims 12-13.
- vi) Claim 15 is vague and indefinite in that it is not clear what the claim encompasses.
First, clause (b) is indefinite. What is the clause referring to? It appears to be a double inclusion of the same recited in the preamble. Moreover, the wording is grammatically awkward. What is "mounted on the for" referring to? Substantially the same applies to clause (c).
- vii) In claim 16, l. 5, the phrase "an associated anvil" is vague and indefinite in that it appears to be a double inclusion of the same previously recited.
- viii) Claim 20 is vague and indefinite in that it is not clear what the claim encompasses.
What is "forms an angled" referring to?
- ix) Claim 24 is vague and indefinite in that it is not clear what the claim encompasses.
What is "weighted" referring to, and where is this shown in the drawings? The same applies to the rest of the claims.

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- x) Claim 26 is vague and indefinite in that it is not clear what the claim encompasses. The claim depends from a non elected claim, claim 25. Thus, it is not clear how the claim is further defining the elected invention. For examination on the merits, the claim is treated as if it depends from claim 24. Applicant is advised to change the dependency of claim 26 in the future.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. As best understood, claims 1-21, 24, and 26 are rejected under 35 U.S.C. 102(a) as being anticipated by Smithwick, Jr. et al.

Smithwick Jr. et al discloses an elastomeric scrap ejector for a cutting die comprising all the elements claimed including at least one scrap ejector 10 and a movable flexible finger 16. See whole patent.

Regarding the phrase "adapted to work..." in claim 16, this has not been given significant patentable weight, since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

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Conclusion

11. Rilitz et al, Simpson et al '725, Sarka, Simpson '802, Hofmann, Saunders et al, Smith Jr., and Sandberg are cited as pertinent art.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official

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Gazette of the Patent and Trademark on February 25, 1997 at 1195
OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group receptionist whose telephone number is (703) 308-1148.


Charles Goodman
Patent Examiner
AU 3724

cg
August 14, 1999